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*Admitted only in Maryland
*Admitted only in Virginia
•Practice Limited to
Federal Agencies

1634
A
BFW

September 7, 2004

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Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Art Unit 1634

Re: U.S. Utility Patent Application
Application No. 09/829,066; Filed: April 10, 2001
For: **Method for Isolating and Recovering Target DNA or RNA Molecules
Having a Desired Nucleotide Sequence**
Inventors: Nisson *et al.*
Our Ref: 0942.4800002/RWE/ALS

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Credit Card Payment Form PTO-2038;
2. Fee Transmittal (Form PTO/SB/17);
3. Second Supplemental Information Disclosure Statement;
4. Two (2) pages of Form PTO-1449 citing six (6) references;
5. A copy of the six (6) cited references; and
6. One (1) return postcard..

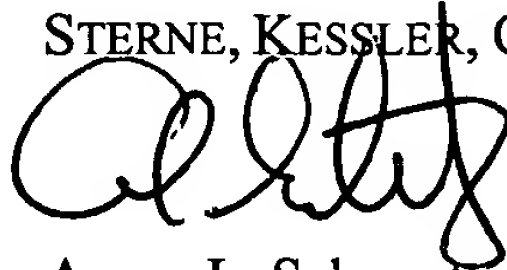
It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

Commissioner for Patents
September 7, 2004
Page 2

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

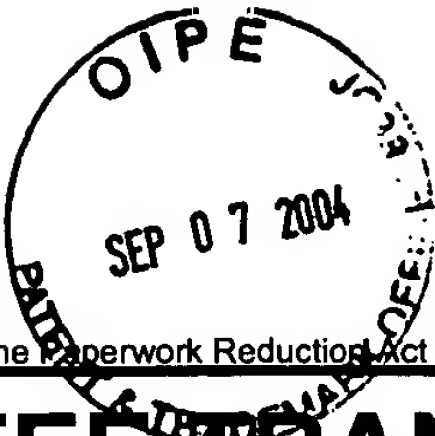
Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Aaron L. Schwartz
Agent for Applicants
Registration No. 48,181

ALS/law
Enclosures
307706v1.



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FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 180.00

Complete if Known

Application Number	09/829,066
Filing Date	April 10, 2001
First Named Inventor	Paul E. Nisson
Examiner Name	Lu, Frank Wei Min
Art Unit	1634
Attorney Docket No.	0942.4800002/RWE/ALS

METHOD OF PAYMENT (check all that apply)

☐ Check ☒ Credit card ☐ Money Order ☒ Other** ☐ None

☐ **Charge any deficiencies or credit any overpayments in the fees to Deposit Acct. No. 19-0036.

Deposit Account Number
Deposit Account Name

19-0036

Sterne, Kessler, Goldstein & Fox P.L.L.C.

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Credit any overpayments

☐ Charge any additional fee(s) or any underpayment of fee(s)

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)				(\$)	-0-

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims - 20 **= X =
Independent Claims - 3 **= X =
Multiple Dependent =

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$) -0-

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	180
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 180.00

SUBMITTED BY

(Complete if applicable)

Name (Print/Type)

Aaron L. Schwartz

Registration No.
(Attorney/Agent)

48.181

Telephone

(202) 371-2600

Signature

Date

September 7, 2004

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

NISSON *et al.*

Appl. No.: 09/829,066

Filed: April 10, 2001

For: **Method for Isolating and
Recovering Target DNA or RNA
Molecules Having a Desired
Nucleotide Sequence**

Confirmation No.: 1532

Art Unit: 1634

Examiner: Lu, Frank Wei Min

Atty. Docket: 0942.4800002/RWE/ALS

Second Supplemental Information Disclosure Statement

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§1.56, 1.97 and 1.98. A copy of each of these documents is provided.

The numbering of this Second Supplemental Information Disclosure Statement is a continuation of Applicants' First Supplemental Information Disclosure Statement filed July 16, 2002, in connection with the above-captioned application.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed publication dates on the attached PTO-1449 based on information presently available to the undersigned. However, the listed publication dates

should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

Document AP1 is in the French language. Document AT16 is in the Russian language. These documents were cited in a Search Report dated July 6, 2004, issued by the European Patent Office in EP 98931513, which is the European counterpart of the above-captioned U.S. Patent Application. The requirement for a concise explanation of the relevance of AP1 and AT16 under 37 C.F.R. § 1.98(a)(3)(i) is satisfied by the submission herewith of the Supplementary Partial European Search Report (document AR17) in which the relevance of AP1 and AT16 is indicated. *See* M.P.E.P. § 609.III.A(3).

This Information Disclosure Statement is being filed more than three months after the U.S. filing date and after the mailing date of the first Office Action on the merits, but before the mailing date of a Final Rejection, or Notice of Allowance, or an action that otherwise closes prosecution in the application. Attached is our PTO-2038

Credit Card Payment Form in the amount of \$180.00 in payment of the fee under 37 C.F.R. § 1.17(p).

It is respectfully requested that the Examiner initial and return a copy of the enclosed PTO-1449, and to indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

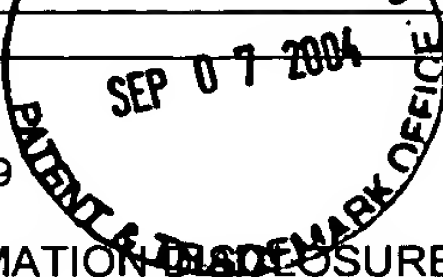
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

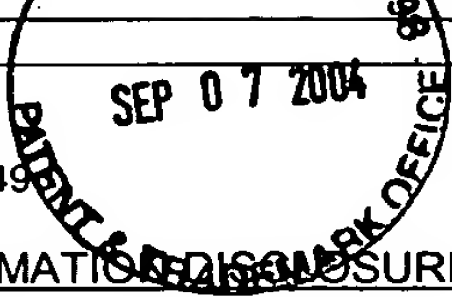


Aaron L. Schwartz
Agent for Applicants
Registration No. 48,181

Date: September 7, 2004

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

				Page 1 of 2		
FORM PTO-1449				ATTY. DOCKET NO. 0942.4800002/RWE/ALS		
SECOND SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT				APPLICATION NO. 09/829,066		
				FIRST NAMED INVENTOR NISSON <i>et al.</i>		
				FILING DATE April 10, 2001		
				ART UNIT 1634		
U.S. PATENT DOCUMENTS						
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	FILING DATE
	AA					
	AB					
	AC					
	AD					
	AE					
	AF					
	AG					
	AH					
	AI					
	AJ					
	AK					
FOREIGN PATENT DOCUMENTS						
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	TRANSLATION
	AL					Yes No
	AM					Yes No
	AN					Yes No
	AO					Yes No
	AP1	FR 2 733 515 A1	10/31/1996	France		Yes X No
OTHER (Including Author, Title, Date, Pertinent Pages, etc.)						
	AR					
	AS					
	AT	16	Smol'yaninova, T.I., <i>et al.</i> , "Model Studies of DNA-Protein Interactions. I. Effect of Aminocarboxylic and Amide Groups of Amino Acids on the Thermostability and Conformation of DNA," <i>Molekulyarnaya Biologiya</i> 19:992-1000, Maik Nauka/Interperiodica Publishing (1985)			
EXAMINER					DATE CONSIDERED	
EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.						

Page 2 of 2							
FORM PTO-1449 SECOND SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT	<div style="text-align: center; margin-bottom: 10px;">  </div> <table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="width: 50%;">ATTY. DOCKET NO. 0942.4800002/RWE/ALS</td> <td style="width: 50%;">APPLICATION NO. 09/829,066</td> </tr> <tr> <td colspan="2">FIRST NAMED INVENTOR NISSON <i>et al.</i></td> </tr> <tr> <td>FILING DATE April 10, 2001</td> <td>ART UNIT 1634</td> </tr> </table>	ATTY. DOCKET NO. 0942.4800002/RWE/ALS	APPLICATION NO. 09/829,066	FIRST NAMED INVENTOR NISSON <i>et al.</i>		FILING DATE April 10, 2001	ART UNIT 1634
ATTY. DOCKET NO. 0942.4800002/RWE/ALS	APPLICATION NO. 09/829,066						
FIRST NAMED INVENTOR NISSON <i>et al.</i>							
FILING DATE April 10, 2001	ART UNIT 1634						

U.S. PATENT DOCUMENTS							
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA						
	AB						
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						

FOREIGN PATENT DOCUMENTS							
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL2	EP 0 773 225 A2 & A3	05/14/1997	Europe			Yes No
	AM2	WO 95/09915	04/13/1995	WIPO			Yes No
	AN2	WO 97/20918	06/12/1997	WIPO			Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)			
	AR	<u>17</u>	Supplementary Partial European Search Report, issued by the European Patent Office in European Patent Application No. 98931513, July 6, 2004
	AS	<u>17</u>	
	AT		

EXAMINER	DATE CONSIDERED
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EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.